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EXAMINER

CHANKONG, DOHM

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD FRANCIS RUSSELL,
LAWRENCE RUSSELL STEWARD, MICHAEL RAY TIMPERMAN,
JASON ERIC WALDECK, and CHARLES THOMAS WOLFE

Appeal 2008-1822
Application 09/818,179
Technology Center 2400

Decided: November 20, 2008

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal the Examiner's final rejection of claims 1-23 under 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b)(2002).

A. INVENTION

According to Appellants, the invention relates to a method of sharing a printer, and more particularly, to a method of sharing a printer on a computer network (Spec. 1, ll. 6-7).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method of sharing a printer between a plurality of users on a computer network, said method comprising the steps of:

attaching host-based networking hardware to the printer;

providing a network communication protocol defining a command channel and a data channel;

allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis; and

instructing the host-based networking hardware to accept information on the data channel only from the user that owns the data channel.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yamazaki US 6,785,727 B1 Aug. 31, 2004

Claims 1-10, 12, 17, 18, and 20-23 stand rejected under 35 U.S.C. § 102(e) over the teachings of Yamazaki; and

Claims 11, and 13-16 stand rejected under 35 U.S.C. § 103(a) over the teachings of Yamazaki.

We affirm-in-part.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that claims 1-10, 12, 17, 18, and 20-23 are anticipated under 35 U.S.C. § 102(e) by the teachings of Yamazaki, and that claims 11, and 13-16 are obvious over the teachings of Yamazaki. In particular, the issues turn on whether Yamazaki discloses “attaching host-based networking hardware to the printer,” and “allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis” (Claim 1), and whether it would have been obvious from the teachings of Yamazaki to send acknowledgements to the user of the data channel (Claim 11).

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Yamazaki

1. Yamazaki discloses a printer control unit 1001 which controls the whole of the printer 1000 and analyzes character information and the like supplied from the host computer (col. 4, ll. 2-5).

2. The system in Yamazaki makes it possible for a specified user to reserve a printer time and limits the processing of a print job at a non-reserver in a reserved time zone, wherein a job of a party other than a reserver is rejected in a reserved time zone and only a print job of a reserver is quickly processed in a reserved time zone (col. 7, ll. 43-60).

IV. PRINCIPLES OF LAW

35 U.S.C. § 102

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted). “Anticipation of a patent claim requires a finding that the claim at issue ‘reads on’ a prior art reference.” *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (citations omitted).

The *claims* measure the invention. See *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed.

Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). "[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

KSR Int’l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

V. ANALYSIS

35 U.S.C. § 102

Claims 1-10, 12, 17, 18, and 20-23

Appellants do not provide separate arguments with respect to the rejection of claims 1-10, 12, 17, 18, and 20-23. Therefore, we select independent claim 1 as being representative of the cited claims. 37 C.F.R. § 41.37(c)(1)(vii).

In the Appeal Brief, Appellants argue that “the system disclosed in Yamazaki does not satisfy Applicants’ definition of a host-based paradigm” because “the control unit 1001 of printer 1000 in Yamazaki must perform resource intensive tasks” (App. Br. 14). However, Appellants’ “must perform resource intensive tasks” argument is not commensurate with the claimed invention since such limitation is not expressly recited in the claim language. Thus, the issue that we address on appeal is whether Yamazaki discloses “host-based networking hardware” (claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation. *See In re Bigio* at 1324. Furthermore, our analysis will not read limitations into the claims from the specification. *See In re Van Geuns* at 1184. It is the Appellants’ burden to precisely define the invention. *See In re Morris* 127 F.3d 1048, 1056 (Fed. Cir. 1997). Appellants’ claims simply do not place any limitation on what “host-based” in “host-based networking hardware” represents, other than that the host-based networking hardware is attached to the printer.

We agree with the Examiner's finding that Yamazaki discloses the claimed elements on appeal beginning at page 3 of the Answer, and including the Examiner's corresponding responsive arguments beginning at page 11 of the Answer. As the Examiner finds, "[t]he control unit is used in order to enable all communications between the printer and the host system and it communicates directly with host computer 2000. Thereby, the control unit is considered to meet the limitation of 'host-based' as recited in the claim" (Ans. 11).

Yamazaki discloses a printer control unit 1001 which controls the whole of the printer 1000 and analyzes character information and the like supplied from the host computer (FF 1). Therefore, we agree with the Examiner that such printer control unit 1001 is networking hardware that is host-based since it communicates directly with the host computer 2000. We thus agree with the Examiner that Yamazaki discloses "host-based networking hardware," as claimed (claim 1).

Appellants also argue that Yamazaki differs from the claimed invention because "in accordance with Appellants' invention, the data channel is shared fairly, i.e., each workstation has an equal chance of capturing the data channel, and also the data channel is shared on a first come first serve basis" (App. Br. 15-16). However, Appellants' "each workstation has an equal chance of capturing the data channel" argument is not commensurate with the claimed invention since such limitation is not recited in the claims. Thus, the issue that we address on appeal is whether

Yamazaki discloses “allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis” (claim 1).

We begin our analysis by giving the claims their broadest reasonable interpretation since Appellants’ claims simply do not place any limitation on what “fair-sharing” represents, other than that the data channel is owned on a fair-sharing first come first serve basis.

We agree with the Examiner’s finding that Yamazaki discloses the claimed elements on appeal beginning at page 4 of the Answer, and including the Examiner’s corresponding responsive arguments beginning at page 11 of the Answer. As the Examiner finds, Yamazaki “clearly shows a user’s ability to reserve a time zone for the use of the printer so that only one user can utilize the printer (i.e. ‘own the data channel’) at any single point in time. This reservation scheme is seen as meeting the limitation of ‘a fair-sharing first come first serve basis’ as it allows only one user to utilize the printer at a time while creating a sharing system that is fair in that users are allocated print times on a first come first serve basis” (Ans. 12).

Yamazaki discloses the user’s ability to reserve a printer time and limits the processing of a print job at a non-reserver in a reserved time zone, wherein a job of a party other than a reserver is rejected in a reserved time zone and only a print job of a reserver is quickly process in a reserved time zone (FF 2). We agree with the Examiner that such reservation scheme is a first come first serve basis since the reserved time is a single point in time in

which the first user to reserve (first come) may exclusively own (first serve) the data channel, wherein the scheme is fair sharing in that it allows sharing of the data channel based on the reservation, not on a subjective standard. We thus agree with the Examiner that Yamazaki discloses “allowing only one of the users to own the data channel at any single point in time on a fair-sharing first come first serve basis” (claim 1).

Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting independent claim 1, and claims 2-10, 12, 17, 18 and 20-23 falling with claim 1, under 35 U.S.C. § 102(e).

Claim 5

As to claim 5, Appellants add that “the status response [of the claimed invention] indicates the user that owns the data channel” while the “Owner” of Yamazaki is “the Owner of the document” (App. Br. 18). However, such argument by Appellants that the Owner of the document in Yamazaki is not a user that owns the data channel is not commensurate with the claimed invention. That is, Appellants appear to be arguing that the owner *only* owns the data channel, and thus, cannot *also* be the owner of the document. Such “only” argument is not commensurate with the claimed invention.

The Examiner finds that “the ‘Owner’ of each print job... [is] the user that owns the data channel during that time” (Ans. 14). We agree with the Examiner. An artisan would have understood that when the data channel is reserved for a user, only the reserving user (the document owner) is allowed to own the data channel at that reserved single point in time.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 102(e).

Claim 8

As to claim 8, Appellants add that Yamazaki “is not directed to sending a connect signal on the command channel” (App. Br. 19). However, the Examiner finds that “[a] reservation request is sent on the command channel and allows the user to acquire the data channel, thus it is seen to meet the limitation of ‘a connect signal’ as claimed” (Ans. 15). Appellants provide no argument to dispute that the Examiner has correctly shown where all the claimed elements appear in the prior art, and do not submit any corresponding arguments in the Reply Brief to contest the Examiner’s finding.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 8 under 35 U.S.C. § 102(e).

Claim 12

As to claim 12, Appellants add that Yamazaki makes “no reference to a ‘host-based networking hardware discarding any said communication frame that does not have an expected said sequence number’” (App. Br. 20). However, the Examiner finds that “Yamazaki’s system discards all data not from the user of the current print job (i.e. the owner of the data channel)” (Ans. 15). We agree with the Examiner that such discarded data includes the communication frame that does not have an expected sequence number.

Though, in the Reply Brief, Appellants argue that “‘ignoring’ a command is not akin to discarding a communication frame” (Reply Br. 9), Yamazaki discloses instead, as set forth by the Examiner, “cancelling” a command and not “ignoring” as misstated by the Appellants. An artisan would have understood that when a command is canceled, as the Examiner finds, all data not from the user of the current print job is discarded, including a communication frame that does not have an expected sequence number.

Accordingly, we conclude that Appellants have not shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 102(e).

35 U.S.C. § 103(a)

Claims 11 and 13-16

As to claims 11 and 13-16, though the Examiner admits that “Yamazaki did not explicitly disclose that his printer system would send acknowledgements to the user of the data channel,” the Examiner finds that “the use of acknowledgements between two such devices in a computer network is commonly practiced in the art” (Ans. 8). However, Appellants contend that “to merely say it would be obvious to send acknowledgements to the user of the data channel is to ignore the type, or content, of the acknowledgement being sent and the conditions under which the acknowledgement is being sent” (Reply Br. 10). Thus, the issue that we

address on appeal is whether it would have been obvious from the teachings of Yamazaki to send acknowledgements to the user of the data channel (Claim 11).

As the Examiner admits, Yamazaki does not disclose the cited limitations. We thus agree with Appellants that Yamazaki does not disclose or even suggest such cited limitations. As such, we find that the Appellants have shown that the Examiner has not established the *prima facie* case obviousness of the claimed invention set forth in claims 11 and 13-16.

Therefore, we will not sustain and will instead reverse the Examiner's rejection of claims 11 and 13-16 under 35 U.S.C. § 103 for the reasons as set forth above.

CONCLUSIONS OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1-10, 12, 17, 18, and 20-23 are anticipated the teachings of Yamazaki.

(2) Appellants have shown that the Examiner erred in finding claims 11 and 13-16 are unpatentable over the teachings of Yamazaki.

(3) Claims 1-10, 12, 17, 18, and 20-23 are not patentable.

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DECISION

The Examiner's decision rejecting claims 1-10, 12, 17, 18, and 20-23 under 35 U.S.C. § 102(e) is affirmed and the Examiner's decision rejection claims 11 and 13-16 under 35 U.S.C. § 103(a) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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